



Atty. Docket No. 16454.0002 D2

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:

*Friedman et al.*

Appl. No.: 10/780,295

Filed: February 17, 2004

For: Modulators of Body Weight,  
Corresponding Nucleic Acids and  
Proteins, and Diagnostic and  
Therapeutic Uses Thereof

Confirmation No.: 7125

Art Unit: 1647

Examiner: Saoud, Christine J.

Atty. Docket: 16454.0002 D2

**APPLICATION FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT**  
**UNDER 37 C.F.R. §1.705(b)**

**Mail Stop – Patent Ext.**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicant respectfully requests reconsideration of the Patent Term Adjustment indicated on page 3 of Form PTOL-85 (i.e., Determination of Patent Term Adjustment under 35 U.S.C. 154(b)), which Form PTOL-85 was mailed October 8, 2008. Applicant herein applies for an adjustment of the patent term due to, at least, to a delay on the part of the Patent Office in issuance of the patent. Applicant further submits for consideration, a statement of the facts involved as required under 37 CFR 1.705(b)(2).

The Commissioner is authorized to charge \$200 to the Deposit Account 19-4293 for the petition fee as set forth in 37 CFR 1.18(e). Should this fee be in error, the Commissioner is hereby authorized to debit or credit Deposit Account 19-4293.

Respectfully submitted,

Date: 1-7-09  
Steptoe & Johnson LLP  
1330 Connecticut Avenue, NW  
Washington, DC 20036-1795  
Phone: 202-429-3000  
Fax: 202-429-3902

  
Harold H. Fox  
Reg. No. 41,498



Re: Reconsideration of Patent Term Adjustment  
Appln. No.: 10/780,295  
Atty. Docket: 16454.0002 D2  
Page 1

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

*Friedman et al.*

Appl. No.: 10/780,295

Filed: February 17, 2004

For: Modulators of Body Weight,  
Corresponding Nucleic Acids and  
Proteins, and Diagnostic and  
Therapeutic Uses Thereof

Confirmation No.: 7125

Art Unit: 1647

Examiner: Saoud, Christine J.

Atty. Docket: 16454.0002 D2

### Statement of Facts in Support of Application for Reconsideration of Patent Term Adjustment Pursuant to 37 C.F.R. § 1.705(b)

Mail Stop – Patent Ext.  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This Statement of Facts is being submitted pursuant to in support of an Application for Reconsideration of Patent Term Adjustment under 37 C.F.R. § 1.705(b).

The Patent Term Adjustment (PTA) that is indicated on page 3 of Form PTOL-85 (i.e., Determination of Patent Term Adjustment under 35 U.S.C. 154(b)) is 330 days. Applicant submits that the correct PTA is 586 days, in view of 37 C.F.R. §§ 1.703– 1.705 and as clarified in the recent decision in *Wyeth v. Dudás*, No. 07-1492 (D.D.C. 2008). Relevant instances, and associated dates and impact of such instances to the correct PTA to which the above-identified patent is entitled, follow.

Relevant instances, and associated dates and accorded PTA

The PTA calculation for this application begins with the actual date that the above-identified application was filed under 35 U.S.C. 1.111(a) and the requirements of C.F.R. § 1.53(b) satisfied, which is February 17, 2004. Review of all instances that have occurred subsequent to the actual filing date and up to the mailing of the Notice of Allowability for the above-identified application that may impact PTA reveals that there are three instances under 37 C.F.R. § 1.702 and 37 C.F.R. § 1.703 that properly increase PTA and three instances under 37 C.F.R. § 1.704 that reduce PTA for the above-identified patent. The relevant dates of these instances, and PTA accorded these instances, are provided below and further outlined in EXHIBIT A, attached hereto.

1. On June 26, 2006, the Patent office mailed a first non-final Office Action (i.e., a Requirement for Restriction/Election). Under 37 C.F.R. § 1.703(a)(1), the Office's delay in mailing the non-final Office Action increases PTA by 435 days.
2. On September 29, 2006, Applicant mailed a Response to the non-final Office Action referenced in Item 1. Under 37 C.F.R. § 1.704(b), Applicant's delay in responding to the non-final Office Action reduces PTA by 3 days.
3. On July 5, 2007, Applicant mailed a Response to non-final Office Action, which non-final Office Action was mailed on January 10, 2007. Under 37 C.F.R. § 1.704(b), Applicant's delay in responding to the non-final Office Action reduces PTA by 86 days.
4. On October 30, 2007, Applicant filed a Request for Continued Examination in response to a final Office Action, which final Office Action was mailed on September 19, 2007. Under 37 C.F.R. § 1.703(b)(1) and in view of the recent decision in *Wyeth v. Dudas*, No. 07-1492 (D.D.C. 2008), the Office's delay in issuing a patent from the subject application within three years of the actual filing date of the subject application, less the number of days beginning from the date of the filing of the RCE and ending on the date on which the patent will ultimately issue, increases PTA by 256 days.
5. On July 2, 2008, Applicant mailed a Response to non-final Office Action, which non-final Office Action was mailed on February 4, 2008. Under 37 C.F.R. § 1.704(b), Applicant's delay in responding to the non-final Office Action reduces PTA by 22 days.

6. On October 10, 2008, the Patent Office mailed a Notice of Allowance in response to Applicant's Response listed in Item 5, above, which Response was mailed on July 2, 2008. Under 37 C.F.R. § 1.703(a)(2), the Office's delay in mailing the Notice of Allowance increases PTA by 6 days.

Applicant states that the above-identified patent is not subject to a terminal disclaimer.

### CONCLUSION

By way of the foregoing comments, attached EXHIBIT A, and the Application submitted herewith, Applicant asserts that the provisions of C.F.R. § 1.705(d) have been satisfied. Accordingly, Applicant respectfully requests reconsideration of PTA calculated by the Patent Office, and correction of the PTA such that the full term adjustment to which the patent is entitled, 586 days, is accorded indicated on the face of the above-identified patent.

No additional fees are believed due for this submission. However, if a fee is due, the Commissioner is hereby authorized to charge payment of any fees associated with this communication, to Deposit Account 19-4293 referencing Docket No. 16454.0002 D2. Additionally, the Commissioner is hereby authorized to charge payment or credit overpayment of any fees during the pendency of this application to Deposit Account 19-4293.

Respectfully submitted,

  
Harold H. Fox  
Reg. No. 41,498

Date: 1-7-09  
Customer Number: 27890  
STEPTOE & JOHNSON LLP  
1330 Connecticut Ave., NW  
Washington, DC 20036  
Tel: 202-429-3000  
Fax: 202-429-3902

EXHIBIT A

Relevant Date	Relevant Instance	Dates for PTA calculation & C.F.R. provision	Days added or subtracted for PTA
February 17, 2004	Subject application filed.	Not applicable.	Not applicable.
June 26, 2006	Restriction Requirement mailed.	February 17, 2004, through June 26, 2006.  §§1.702(a)(1) and 1.703(a)(1).	435 days charged to PTO and <b>added</b> to PTA.
September 29, 2006	Response to non-Final Office Action mailed.	June 26, 2006, through September 29, 2006.  §1.704(b).	3 days charged to Applicant and <b>subtracted</b> from PTA.
July 5, 2007	Response to non-Final Office Action mailed.	January 10, 2007, through July 5, 2007.  §1.704(b).	86 days charged to Applicant and <b>subtracted</b> from PTA.
October 30, 2007	Examination	February 17, 2007, through October 30, 2007  §1.703(b)(1).	256 days charged to PTO and <b>added</b> to PTA.
June 2, 2008	Response to non-Final Office Action mailed.	February 11, 2008, through June 2, 2008.  §1.704(b).	22 days charged to Applicant and <b>subtracted</b> from PTA.
October 8, 2008	Notice of Allowance mailed.	June 2, 2008, through October 8, 2008  §1.702(a)(2)	6 days charged to PTO and <b>added</b> to PTA

Total PTA = (Total added days) - (total subtracted days):

Total PTA =  $(435 + 256 + 6) - (3 + 86 + 22)$  = 586 days Correct Total PTA